

Serial No.: 10/769,768
Docket No.: 101-1013
Amendment with RCE dated December 18, 2008
Reply to the Final Office Action of September 18, 2008

REMARKS

Introduction

This paper is filed in connection with the attached Request for Continued Examination (RCE).

Applicant notes with appreciation the Examiner's indication on page 12 of the Office Action mailed on September 18, 2008 that claim 9 would be allowable if rewritten in independent form, after overcoming the §112, second paragraph rejection. However, for at least the reasons set forth below, it is respectfully submitted that all of the pending claims, including claim 9, are allowable over the prior art of record.

Upon entry of the foregoing amendment, claims 1-16 are pending in the application. Claims 1, 6, and 9 have been amended. No new matter is being presented.

In view of the following remarks, reconsideration and allowance of all the pending claims are respectfully requested.

Objection to the Drawings

The drawing of FIG. 9 is objected to under 37 CFR 1.83(a) because it allegedly fails to show a legend describing the labels on the Figure as described in the specification.

Applicant has amended FIG. 9 to include a legend describing reference numbers 138 and 140 as the "FIRST MODULE JACK" and the "SECOND MODULE JACK," respectively. The attached Replacement Sheet includes changes to Fig. 9, and replaces the original sheet including Fig. 9. Support for this change to Fig. 9 can be found, for example, in paragraph [0059] of the specification. Accordingly, no new matter is being added.

Accordingly, it is respectfully submitted that the objection to the drawing of FIG. 9 has been fully addressed and overcome, and withdrawal of the objection is respectfully requested.

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Rejection under 35 USC §112

Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 9 to clarify “a transistor which has a collector to receive the extracted current and a base to receive the internal current...” Support for this amendment can be found, for example, in Fig. 9 and paragraphs [0060-0061]. Accordingly, no new matter is being presented.

In view of these changes to claim 9, it is respectfully submitted that the rejection to claim 9 under 35 U.S.C. §112, second paragraph, has been fully addressed and overcome, and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC §103

1. Claims 1, 4-6, 8, and 10-14

Claims 1, 4-6, 8 and 10-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant Admitted Prior Art (hereinafter “AAPA”) in view of U.S. Patent No. 6,434,232 to Ludeman (hereinafter “Ludeman ‘232”). Reconsideration and withdrawal of the rejection are respectfully requested for at least the following reasons.

Claims 1 and 6

On page 5 of the Office Action mailed on September 18, 2008, the Examiner relies on page 1, paragraphs 0003, 0004 of Applicant’s specification to allege that AAPA teaches “the main terminal maintains the loop voltage generated when the external terminal is in connection with the telephone network.”

In particular, the Examiner maintains in the Examiner’s “Response to Arguments” on page 2 of the Office Action and in the Advisory Action of December 5, 2008 that “[t]he applicant did not claim that the main terminal maintains the constant loop voltage generated when the external terminal is in connection with the telephone network.”

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Applicant has amended claims 1 and 6 to further recite that "the main terminal maintains the loop voltage constant when the external terminal is in connection with the telephone network," to address, without conceding, the Examiner's point.

By this Amendment, Applicant respectfully submits that AAPA and Ludeman '232, whether taken alone or in combination with one another, fail to teach or suggest, among other things, "the main terminal maintains the loop voltage constant when the external terminal is in connection with the telephone network," as presently recited in claims 1 and 6, for at least the following reasons.

Unlike the instant claims, AAPA's first and second loop voltages are not the same, but instead, in fact, are different (paragraph [0004]). AAPA relates to a system such that when the external terminal is disconnected from the telephone network and the main terminal is connected, the voltage changes from the second loop voltage to the first loop voltage (see, paragraphs [0004] and [0005] of Applicant's specification).

For example, as illustrated in FIGS. 1A and 1B of AAPA, when the second DC current signal (section B) is different than the first DC current signal (section C), an interrupt "9" may be generated when the state of the connection with the telephone network is changed, that is, when the second DC current signal changes to the first DC current signal (FIGS. 1A and 1B, paragraph [0005]). This is clearly not the same as "the main terminal maintains the loop voltage constant when the external terminal is in connection with the telephone network," as presently recited in claim 1, and as similarly recited in claim 6, for at least the reason the second DC current signal of AAPA is different than the first DC current signal.

Furthermore, Ludeman '232 does not overcome the deficiencies of AAPA, but was cited merely to allege that the patent discloses "obtaining an internal current from a loop voltage generated (col. 2, lines 27-33)." Accordingly, since Ludeman '232 fails to teach or suggest, among other things, "the main terminal maintains the loop voltage constant when the external terminal is in connection with the telephone network," Ludeman '232 fails to teach or suggest the features that are lacking in AAPA as applied to claims 1 and 6, as pointed out above.

Therefore, even assuming it would be possible to combine AAPA and Ludeman '232 as

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submitted in the Office Action mailed on September 18, 2008 (which it is not), the proposed combination would still fail to teach or suggest, among other things, "the main terminal maintains the loop voltage constant when the external terminal is in connection with the telephone network," as recited in claims 1 and 6.

It is well-settled that "[t]o establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Since AAPA and Ludeman '232, separately or combined, fail to teach or suggest each and every feature of the invention as recited in claims 1 and 6, these claims are patentably distinguishable over AAPA and Ludeman, and withdrawal of the rejection and allowance of claims 1 and 6 are respectfully requested.

Claims 4, 5, 8, and 10-14

With regard to dependent claims 4, 5, 8, and 10-14, it is respectfully submitted that for at least the reason that these claims depend from one of independent claims 1 and 6, respectively, and therefore contain all of the features recited therein, dependent claims 4, 5, 8, and 10-14 are also allowable over the cited references, for at least the reasons in which independent claims 1 and 6 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claims 4, 5, 8, and 10-14 are respectfully requested.

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2. Claims 2, 3, and 7

Claims 2, 3 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Ludeman '232 and further in view of U.S. Patent No. 6,757,378 to Kunisch. Reconsideration and withdrawal of the rejection are respectfully requested for at least the following reasons.

Applicant respectfully references MPEP §2143.03, which states that “[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, for at least the reason that claims 2, 3, and 7 depend from one of independent claims 1 and 6, respectively, and therefore contain all of the features recited therein, dependent claims 2, 3, and 7 are also allowable over the cited references, for at least the reasons in which independent claims 1 and 6 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claims 2, 3, and 7 are respectfully requested.

3. Claims 15 and 16

Claims 15 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of U.S. Patent No. 6,665,398 to Ludeman (hereinafter “Ludeman '398”). The rejection is traversed for at least the following reasons.

Claim 15

On page 11 of the Office Action, the Examiner contends that claim 15 is rejected for the same reasons as claim 1. However, while the Examiner admits that AAPA does not specifically teach a controller controlling the loop voltage constant according to the internal signal, the Examiner alleges that this feature is taught or suggested by Ludeman '398.

Before addressing the Examiner's rejection of claim 15, it is noted that the Office Action does address all of the features recited in claim 15. Upon review of the Office Action, nowhere does the Examiner indicate where Ludeman '398 allegedly teaches “controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected

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to the main terminal,” as recited in claim 15. Instead, the Examiner merely states that Ludeman ‘398 teaches “a controller controlling the loop voltage constant according to the internal signal,” and then jumps to the conclusion that it would be obvious to modify AAPA to keep the voltage constant so that the loop current can somehow be reduced to a value below a threshold value. However, it does not logically follow that the cited references teach or suggest “controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected to the main terminal,” as recited in claim 15.

To the contrary, although Ludeman ‘398 provides a constant loop voltage (V_{on}) when the SLIC is in an on-hook state, Ludeman ‘398 requires the loop voltage to change when the SLIC transitions to an off-hook state (Ludeman ‘398, col. 5, lines 23-24). That is, Ludeman ‘398 does not control the loop voltage constant when the telephone network changes states, but instead merely provides a constant loop voltage V_{on} when the SLIC is in a on-hook state. Then, when the SLIC transitions to an off-hook state, Ludeman ‘398 provides a different loop voltage V_{off} (see, Ludeman ‘398, col. 5, lines 13-24; FIG. 6). By its own terms, then, Ludeman ‘398 limits itself to a system which provides different loop voltages depending on whether the SLIC is in a on-hook or off-hook. This by no means equates to “a controller controlling the loop voltage constant according to the internal signal when the telephone network is disconnected from the external terminal and connected to the main terminal,” as recited in claim 15, for at least the reason that “different” loop voltages are not the same as “constant” loop voltages.

Furthermore, since Ludeman ‘398 makes clear that an essential feature of their invention is to apply a first voltage level in the on-hook condition, and to apply a second voltage in the off-hook condition, one of ordinary skill in the art would not attempt to modify Ludeman ‘398 to provide a constant voltage when the telephone network is disconnected from the external terminal and connected to the main terminal, for at least the reason that this would mean destroying the intended purpose of Ludeman ‘398, which is to provide a different loop voltage V_{off} when the SLIC transitions to an off-hook state.

It is well established that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re*

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Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). References are not properly combinable or modifiable if their intended function is destroyed. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Since the intended function of Ludeman '398 would be destroyed if the reference is modified to arrive at all of the features recited in claims 1 and 6, the reference cannot be properly used to reject claims 1 and 6 under 35 U.S.C. 103(a) as submitted in the Office Action mailed on September 18, 2008.

Finally, since the Office Action has neglected to indicate where the cited references allegedly teach or disclose all of the features recited in claim 15, Applicant respectfully submits that the present Office Action fails to comply with proper examination requirements contained in MPEP §706.07, which states in part that “[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing,” and “in making the final rejection...any such grounds relied on...must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal.”

As pointed out above with respect to independent claims 1 and 6, the Examiner takes the position that “[t]he applicant did not claim that the main terminal maintains the constant loop voltage generated when the external terminal is in connection with the telephone network.” However, Applicant points out to the Examiner that claim 15 clearly recites “controlling the loop voltage constant according to the internal signal when the telephone network is disconnected from the external terminal and connected to the main terminal.” Applicant is thus unclear as to the Examiner’s specific reasons for rejecting claim 15, thus denying Applicant a full and fair hearing with respect to the subject matter of claim 15.

Notwithstanding the improper rejection of claim 15, Applicant has provided a clear distinction between Ludeman '398 and the invention as recited in claim 15, in an effort to expedite prosecution to a successful conclusion.

Accordingly, since AAPA and Ludeman '398, separately or combined, fail to teach or suggest, among other things, “controlling the loop voltage constant when the telephone network is disconnected from the external terminal and connected to the main terminal,” as recited in claim 15, these reference cannot be properly relied upon to reject claim 15 under 35 U.S.C.

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103(a) as submitted in the Office Action mailed on September 18, 2008. Accordingly, withdrawal of the rejection and allowance of claim 15 are respectfully requested.

Claim 16

For at least the reason that claim 16 depends from independent claim 15, and therefore contain all of the features recited therein, dependent claim 16 is also allowable over the cited references, for at least the reasons in which independent claim 15 is allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claim 16 are respectfully requested.

In addition to the fact that claim 16 depends from independent claim 15 as pointed out above, claim 16 is also allowable for its own reasons, since the cited references fail to teach or suggest, among other things, "the controller controls the first DC supply unit to maintain the loop voltage constant when the telephone network is switched from the external terminal to the main terminal," as recited in claim 16, for at least the reasons provided above.

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Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to out Deposit Account No. 502827.

Respectfully submitted,

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